

84



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/942,028      | 08/30/2001  | Mitsuo Yasunobu      | 43890-537           | 7271             |

7590 08/29/2005  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

GRANT II, JEROME

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2626

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/942,028             | YASUNOBU, MITSUO    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jerome Grant II        | 2626                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4,6 and 16-33 is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II  
PRIMARY EXAMINER

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**Detailed Action**

**1.**

Claims 1, 2, 5 and 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "the data" lacks antecedent.

In claim 1, line 3, "the received data" lacks antecedent.

In claim 2, line 17, "the type" lacks antecedent. What type of data is recited ?

In claim 7, line 2, "the data" lacks antecedent.

In claim 7, line 3, "the received data" lacks antecedent.

In claim 7, line 7, "the type" lacks antecedent.

In claim 7, lines 9, "the format" lacks antecedent.

In claim 7, line 11, "the color" lacks antecedent.

In claim 7, lines 12 - 13, "MH data" lacks antecedent.

In claim 11, line 1, "the content" lacks antecedent.

In claim 12, line 1, "the content" lacks antecedent.

Art Unit: 2626

Claims 1, 2, 5 and 7-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

With respect to independent claim 1, this claim contains allowable matter in that the prior art does not teach limitations d) and e).

Independent claim 7 contains allowable matter in that the prior art does not teach limitation e) of the claim.

2.

### **Claims Allowed**

Claims 3, 4, 6 and 16-33 are allowed.

Claims 3, 4 and 6 are allowed for the reason the prior art fails to teach or suggest, the limitation d) in claim 3.

With respect to claims 16, 22 and 28 the prior art fails to teach the first and second converter as claimed.

With respect to claims 17, 23 and 29, the prior art fails to teach or suggest in claimed combination, "... wherein if the data conversion management unit determines that the destination side facsimile apparatus is capable of receiving only color image, the facsimile apparatus transmits color image data of the third format to the destination inside facsimile apparatus, and if the data conversion management unit determines that the destination side facsimile apparatus is capable of receiving only monochromatic image, the facsimile apparatus transmits data of the monochromatic format to the destination side facsimile apparatus. "

With respect to claims 18, 24 and 30, the prior art fails to teach or suggest, the data conversion management unit and the data format converter as claimed.

With respect to claims 19, 25 and 31 the prior art fails to teach converting the color image data of the second format into color image data of a third format; and transmitting the color image of the third format via a communication line.

With respect to claims 20, 26 and 32, the prior art fails to teach converting the color image data of the second format into color image data of a third format; converting the color image data of the third format into monochromatic image data; and transmitting the monochromatic image data via a communication line.

With respect to claims 21, 27 and 33, the prior art does not teach or suggest in claimed combination, "... converting the color image from the second to the third format; converting the color image of the third format into monochromatic image data if the destination side facsimile apparatus can receive only monochromatic data according to the step of determination and transmitting the monochromatic or third format data via a communication line in response to the step of determination."

3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

**JEROME GRANT II**  
**PRIMARY EXAMINER**